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Elizabeth Miller

Elizabeth Miller

07/10/2003

Date

#ce/K.T.

ATTY DOCKET NO. 10992786-1

7/31

ELECT.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jeffrey R. Sampson *et al.* Group Art Unit: 1635

Serial No.: 09/632,639 Examiner: Mary M. Schmidt

Filed: 07/31/2000

Title: INHIBITION OF TARGET-MEDIATED CROSS-HYBRIDIZATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO RESTRICTION REQUIREMENT

The examiner is thanked for the Office Action mailed 06/10/2003 (restriction requirement only). The examiner identified three species of the claimed invention. In response to the restriction, Applicants elect the species of identified Group (1) (type of target nucleic acid, RNA or DNA). As noted by the examiner claims 1-26 are generic to the elected species. This election is made with traverse for the reasons discussed below.

Applicants traverse the species restriction requirement on the basis that the examiner has not advanced any reasons or examples to show that the restriction requirement is proper. In particular, restriction following from such election (if generic claims were not found allowable) is only proper when the overriding two conditions required by M.P.E.P. §803 are present (note that under 802.02 an election of species requirement is a "Restriction"):

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“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a **serious burden** on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).” (emphasis added)

Further, as stated immediately under the “Guidelines” sub-title of M.P.E.P §803:

“Examiners **must provide reasons and/or examples to support conclusions**, but need not cite documents to support the requirement in most cases.”...

“For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP Section 808.02.” (emphasis added)

In the present case the examiner has not made a *prima facie* showing of a serious burden for restriction with respect to the various identified species by any of the above means (and has not attempted to do so).

The above requirements are further echoed in M.P.E.P 808.02, which requires that when related inventions (which all of the claimed species of the present case are, and the examiner has not alleged otherwise) are distinct, then:

“the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) Separate classification thereof: ...

(B) A separate status in the art when they are classifiable together: ...

(C) A different field of search:...

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among related inventions.”**

Again, the examiner has not met any of the required showings (and has not attempted to do so). That being the case, the Examiner has not made the *prima facie* showing required of her by M.P.E.P. 803. Accordingly, the election requirement set out in the Office Action should be withdrawn.

If there are any outstanding issues which might be resolved by means of a telephone conference, the examiner is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



Gordon Stewart  
Attorney for Applicants  
Reg. No. 30,528

Agilent Technologies  
Legal Department, DL429  
IP Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

10992786-1 Resn Response

AGILENT TECHNOLOGIES, INC.  
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## PATENT APPLICATION

ATTORNEY DOCKET N . 10992786-1

1635

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Attv ntor(s): Jeffrey R. Sampson et al.

Serial N .: 09/632,639

Examin r: Mary M. Schmidt

Filing Date: 07/31/2000

Group Art Unit: 1635

Title: INHIBITION OF TARGET-MEDIATED CROSS-HYBRIDIZATION

COMMISSIONER FOR PATENTS  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

(X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee (Address envelope to "Box Non-Fee Amendments")  
( ) Other: \_\_\_\_\_ (fee \$ \_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	26	MINUS	26	= 0	X \$18	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$84	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$410.00	3RD MONTH \$930.00	4TH MONTH \$1450.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Jeffrey R. Sampson et al.

By 

Gordon M. Stewart

Attorney/Ag nt for Applicant(s)  
Reg. No. 30,528

Date: 07/10/2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

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